REMARKS

Claims 7-12 remain in the present application. Claims 7 and 12 were amended in this response. No new matter has been introduced as a result of the amendment. Favorable reconsideration is respectfully requested.

Claims 7-12 were rejected under 35 U.S.C. §103(a) as being unpatentable over *Bernstein et al.* (US Patent 6,404,765) in view of *Westberg* (US Patent 6,041,054) and *Bharucha et al.* (US Patent 6,229,821). Applicants respectfully traverse this rejection.

Specifically, the cited references do not teach or suggest connecting exchanges via a packet-oriented communication network, wherein data transmission involves Internet Protocol data packets subdivided into substructure elements as recited in claim 7. Instead, each of the cited references are directed to transferring data packets in an asynchronous time-division multiplexed (ATM) network, which is a connection-oriented network, where ATM cells are transported as data packets (see Berstein, col. 1, lines 22-45, distinguishing between TCP/IP and ATM).

Furthermore, claim 7 recites features to transparently transmit data by inserting the substructure elements into data packets unchanged, transmitting the data packets, extracting the substructure elements from the transmitted data packets, and forwarding the extracted substructure elements unchanged to a receiving exchange. The substructure elements include both a cell header and a payload data (useful data) area. Therefore, the cell header is also inserted, transmitted, and extracted unchanged together with the payload data. One advantage of such a transparent transmission of substructure elements via data packets is that the conversion devices do not require complex processing and no coding/decoding or compression/decompression steps are needed in the conversion devices or in internal routing devices of the packet-oriented network.

In contrast, *Bernstein* discloses a method and an apparatus to transport synchronous time-slot based DS-X traffic after a conversion over an ATM network with end nodes supporting DS-X traffic (see Abstract). However, in DS-X traffic no cell header is used for the transmission (col. 1, lines 53-67; col. 2, lines 1-30). As such, the disclosure in *Bernstein* teaches away from the present claims as the introduction of a cell header would run contrary to the teaching of

Bernstein as the header would reduce the available bandwidth for the transmission (col. 4, lines 46-50).

Westberg also does not teach or suggest inserting substructure elements (cell header and payload) into data packets unchanged. To the contrary, Fig. 2 discloses different size AAL2 minicells in the top row compared to the bottom row, whereas differently sized cells in the top row appear as same sized blocks in an ATM cell (e.g. third AAL2 minicells from the right and second AAL2 minicells from the right are clearly different in size in the top row but roughly the same size in the bottom row). Accordingly, the AAL2 minicells will not stay unchanged when they get inserted into an ATM cell.

Furthermore, Applicants submit that there is no teaching, suggestion or motivation for one of ordinary skill in the art to combine the *Bernstein* and *Westberg* references in the manner suggested in the Office Action. In making a determination that an invention is obvious, the Patent Office has the initial burden of establishing a *prima facie* case of obviousness. *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S. P.Q.2d 1955, 1956 (Fed. Cir. 1993). "If the examination at the initial stage does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of the patent." *In re Oetiker*, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992).

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985). When the motivation to combine the teachings of the references is not immediately apparent, it is the duty of the examiner to explain why the combination of the teachings is proper. *Ex parte Skinner*, 2 USPQ2d 1788 (Bd. Pat. App. & Inter. 1986). (see MPEP 2142).

Further, the Federal Circuit has held that it is "impermissible to use the claimed invention as an instruction manual or 'template' to piece together the teachings of the prior art so that the claimed invention is rendered obvious." *In re Fritch*, 23 U.S.P.Q.2d 1780, 1784 (Fed. Cir. 1992). "One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention" *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988).

Moreover, the Federal Circuit has held that "obvious to try" is not the proper standard under 35 U.S.C. §103. *Ex parte Goldgaber*, 41 U.S.P.Q.2d 1172, 1177 (Fed. Cir. 1996). "An-obvious-to-try situation exists when a general disclosure may pique the scientist curiosity, such that further investigation might be done as a result of the disclosure, but the disclosure itself does not contain a sufficient teaching of how to obtain the desired result, or that the claim result would be obtained if certain directions were pursued." *In re Eli Lilly and Co.*, 14 U.S.P.Q.2d 1741, 1743 (Fed. Cir. 1990).

Specifically, neither *Bernstein* nor *Westberg* provide a teaching, suggestion or motivation to transmit data via a packet oriented network by subdividing data traffic packets into AAL2 minicells within ATM cells, as alleged by the Office Action. *Bernstein* discloses a method and an apparatus to transport synchronous time-slot based DS-X traffic after a conversion from an ATM network with end nodes supporting DS-X traffic. The Office Action alleges that *Westberg* teaches a method and apparatus for ATM systems wherein serial DS-X traffic packets may be further subdivided into AAL2 substructure elements. However, this is incorrect, because DS-X traffic is a time-slot based format that would not lead to an AAL2 data packet simply by subdividing it. To the contrary, subdividing would lead to a fraction of a DS-X frame or a fraction of a DS-X channel that would be useless unless signaling or managing data would be added to enable a rebuilding of the DS-X traffic on the receiving side of this connection from received packet data. Moreover, since the DS-X traffic of *Bernstein* is a connection-oriented format and *Westberg* discloses packetized data (especially IP data) as the payload to be transmitted over an ATM network, a person skilled in the art would not turn to *Westberg*, because packet-oriented principles can not be directly incorporated into a connection-oriented transmission. Accordingly, the Applicants respectfully submit the rejection under 35 U.S.C. §103 is improper and should be withdrawn.

In light of the above, Applicants respectfully submit that independent claim 7 of the present application, as well as claims 8-12 which respectfully depend therefrom, are both novel and non-obvious over the art of record. Accordingly, Applicants respectfully request that a timely Notice of Allowance be issued in this case.

It is further submitted that no fees are due in connection with this response at this time. However, if any fees are due in connection with this application as a whole, the Examiner is authorized to deduct said fees from Deposit Account No.: 02-1818. If such a deduction is made, please indicate the attorney docket number (0112740-177) on the account statement.

Respectfully submitted,

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